

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hyun-kwon CHUNG et al.

Application No. 10/686,521

Group Art Unit: 2194

Confirmation No. 4904

Filed: October 16, 2003

Examiner: Nathan E. Price

For: DATA STORAGE MEDIUM HAVING INFORMATION FOR CONTROLLING BUFFERED
STATE OF MARKUP DOCUMENT, AND METHOD AND APPARATUS FOR
REPRODUCING DATA FROM THE DATA STORAGE MEDIUM

RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Information Under 37 CFR 1.105 mailed October 19, 2007, and having a period for response set to expire on December 19, 2007, and the Interview Summary mailed on November 14, 2007.

Applicants' Statement of Substance of Interviews

The Interview Summary mailed on November 14, 2007, for the telephone interviews conducted on November 8 and 9, 2007, between Examiner Nathan E. Price and the undersigned attorney is acknowledged. The applicants' statement of the substance of the interviews required by MPEP 713.04 is as follows.

On November 8, 2007, the attorney called the Examiner and told him that the applicants consider the Requirement for Information to be unreasonable in light of the fact that the Examiner was able to search the prior art and issue two Office Actions without the information he has now required in the Requirement for Information. Also, the attorney pointed out that Application Nos. 10/686,537, 10/685,694, and 10/685,696 were filed on the same day as the

present application and have the same specification and drawings as the present application. The attorney pointed out that the Examiner of the present application is also the Examiner of Application No. 10/686,537, and the Examiner was able to search the prior art and issue two Office Actions in that application without the information he has now required in the Requirement for Information. The attorney pointed out that the Examiners of Application Nos. 10/685,694 and 10/685,696 were able to search the prior art and issue Office Actions (five in 10/685,684 and one in 10/685,696) without the information the Examiner of the present application has now required in the Requirement for Information.

The Examiner said he had discussed the Requirement for Information with his supervisor before it was issued, but that he would discuss the applicants' concerns with his supervisor and call the attorney back.

On November 9, 2007, the Examiner called the attorney and said that he had discussed the applicants' concerns with his supervisor, but that he and his supervisor had determined that the Requirement for Information was proper.

That same day, November 9, 2007, the attorney called the Examiner's supervisor, Supervisory Patent Examiner William Thomson, and discussed this matter with him.

The supervisor explained that the Examiner had issued the Requirement for Information because it was unclear from the comments regarding the rejection of claims 23 and 24 under 35 USC 112, second paragraph, on pages 19 and 20 of the Amendment of September 5, 2007, whether the applicants had changed "enhanced audio [and] video (ENAV)" in paragraphs [0022] and [0070] of the specification and claim 23 to "enhanced navigation (ENAV)" because that is what the applicants consider ENAV to actually mean, or whether the applicants had changed it merely because the Examiner had said that "the accepted meaning [of ENAV] is 'enhanced navigation' " at the bottom of page 8 of the Office Action of June 6, 2007.

Also, the supervisor explained that although the Examiner had found information about enhanced navigation (ENAV) in his latest search, the Examiner had been unable to determine if any of the ENAV features disclosed in the present application are part of the prior art.

The attorney told the supervisor that it would be very burdensome to provide complete English translations of the eight Korean priority applications of the present application as required in point A of the Requirement for Information. The attorney pointed out that the

applicants have already filed an English translation of the Korean priority application with the oldest filing date on March 9, 2007, i.e., Korean Application No. 2002-63631 filed on October 17, 2002. The supervisor told the attorney that the applicants can provide an English translation of only any portions of the other seven Korean priority applications that define "ENAV."

The attorney explained to the supervisor that the invention disclosed in the present application was probably made more than 5 years ago, and accordingly it is unlikely that the applicants or the assignee will be able to identify documents they may have used in making the invention or drafting the present application.

The supervisor said that he understands the difficulties presented by the Requirement for Information, and said that if the applicants or the assignee do not have the information required by the Examiner or cannot readily obtain the required information, they merely have to provide a statement to that effect.

Response to Requirement for Information Under 37 CFR 1.105

On pages 4-6 of the Requirement for Information, the Examiner has required the applicants and the assignee, Samsung Electronics Co., Ltd., to provide the following information pursuant to 37 CFR 1.105:

- A. A translation in the English language of each foreign application to which Applicant claims priority that is not in the English language and discloses ENAV, regardless of the meaning of ENAV in the foreign application. See 37 C.F.R. 1.55(a)(4).
- B. Stipulate, for Applicant's original disclosure and for each foreign application to which Applicant claims priority and discloses ENAV, whether enhanced audio video (ENAV) refers to the same technology as enhanced navigation (ENAV).
 - 1. If enhanced audio video (ENAV) does refer to the same technology as enhanced navigation (ENAV) for Applicant's original disclosure or any of the foreign applications to which Applicant claims priority and discloses ENAV:
 - a. Provide a copy of any publicly available documents and date of first publication of each document pertaining to the development of enhanced navigation (ENAV) including, but not limited to, specifications, standards, drafts, proposals, reviews/comments, requests

for proposals, and requests for comments of which Applicant is aware regardless of date.

b. Provide a copy of any publicly available documents and date of first publication of each document pertaining to enhanced navigation (ENAV) including, but not limited to, specifications, standards, drafts, proposals, reviews/comments, requests for proposals, and requests for comments of which Applicant is aware and has a publication date that may qualify as prior art under 35 U.S.C. 102 or 103.

c. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) *used in drafting the instant application, whether cited or not* in the IDS submission(s) dated 01/20/2004 or 06/17/2004.

d. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was *used in the inventive process to accomplish the applicant's inventive results*.

e. Provide the date of first use of the claimed invention, known to by any of the inventors or Applicant, at the time the application was filed *notwithstanding* the date of use.

f. Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the *claimed* subject matter or enhanced navigation (ENAV) has been embodied in.

Also, the Examiner states as follows on page 6 of the Requirement for Information (emphasis added):

This request is made in view of the prosecution history with arguments made by Applicant with prior art provided and will assist in determining whether uncovered references and commercially available products might constitute prior art against specific claims pending in the application.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

With respect to item A, it is respectfully requested that the requirement be withdrawn because it is overly burdensome on the applicants and will not "assist [the Examiner] in determining whether uncovered references and commercially available products might constitute prior art against specific claims pending in the application." The present application claims the benefit of eight Korean priority applications having a total of almost 450 pages. The disclosures of the eight Korean priority applications are substantially the same, except for the claims. Furthermore, as discussed above in the Applicants' Statement of Substance of Interview, during the telephone interview conducted on November 9, 2007, between the undersigned attorney and the Examiner's supervisor, the attorney pointed out that the applicants have already filed an English translation of the Korean priority application with the oldest filing date on March 9, 2007, i.e., Korean Application No. 2002-63631 filed on October 17, 2002, and the supervisor told the attorney that the applicants can provide an English translation of only any portions of the other seven Korean priority applications that define "ENAV." However, although "ENAV" is defined as "enhanced audio [and] video" in paragraphs [0022] and [0070] of the specification and claim 23 of the present application, "ENAV" is not defined in any of the eight Korean priority applications. Accordingly, no English translations of any portions of the other seven Korean priority applications are being provided.

With respect to item B, the applicants stipulate, for the applicant's original disclosure and for each of the eight Korean application to which the applicants claims priority and discloses ENAV, that enhanced audio video (ENAV) refers to the same technology as enhanced navigation (ENAV).

With respect to items B(1)(a) through B(1)(f), pursuant to 37 CFR 1.105(a)(4) and MPEP 704.12(b), in response to the requirement for information under 37 CFR 1.105, the applicants and the assignee, after making a reasonable inquiry, hereby reply that the information required to be submitted is unknown to or is not readily available to the applicants and the assignee from which it was requested.

It is noted that the definition of "ENAV" as "enhanced audio [and] video" in paragraphs [0022] and [0070] of the specification and claim 23 of the present application was an error that was corrected in the Amendment September 5, 2007. "ENAV" as used in the present application and in the eight Korean priority applications refers to the Enhanced Navigation technology that

was developed by the DVD Forum as described in an article in *Screen Digest*, London, December 1, 2002. An excerpt of this article is attached hereto and reads as follows:

DVD Forum ad hoc sub-group working on specifications for Web-enabled consumer DVD players was expected to finish a so-called '0.9' version by end 2002 after more than 18 months work. Known as Enav (short for Enhanced Navigation), the specifications build on the Web-enabled DVD technology already developed by InterActual.

Also, J. Taylor et al., *DVD Demystified*, Third Edition, McGraw-Hill Professional, New York, January 31, 2006, ISBN 0071423966, p. 178, contains the following passage:

WebDVD for the Rest of the World

In December 2000, the DVD Forum created a new ad-hoc group (AH1-12) chaired by InterActual Technologies to develop a specification for WebDVD. The idea was to have a single format for consumer DVD players as well as PCs so that there was more incentive for Hollywood studios and others to produce enhanced titles. Members of the ad-hoc group spent years developing what became known as the eNav specification (for enhanced navigation). The format uses XHTML, ECMAScript, and other Web-oriented technologies to add highly interactive control of the DVD-Video portion of discs. But, as the specification neared completion in mid 2003, the next-generation formats were coming to fruition. Many companies, particularly the studios, felt that it was better to wait and incorporate eNav into a single new high-definition format. Thus, eNav died, but from its ashes arose the interactive capabilities of the next-generation formats. Most of the advanced interactivity of HD DVD-Video and BD-J grew from work done on the eNav specification.

As of December 19, 2007, this passage could be viewed by doing a search for "enav" and "interactual" at <http://books.google.com>, but could not be printed. Accordingly, a copy is not attached hereto.

It is noted that InterActual Technologies referred to in the two references discussed above is the assignee of Lamkin et al. (Lamkin '729) (U.S. Patent Application Publication No. 2005/0278729) relied on by the Examiner in the Office Actions of December 12, 2006, and June 6, 2007, and Lamkin et al. (Lamkin '144) (U.S. Patent Application Publication No. 2002/0078144) discussed by the applicants in the Amendments of March 9, 2007, and September 5, 2007, which is a publication of the parent application of Lamkin '144.

Finally, attached hereto is a copy of G. Sharpless, *DVD-Video: Format & Features*, Deluxe Global Media Services, Southwater, West Sussex, UK, July 30, 2003, p. 126, Section 5.5, "Advanced Interactive Features," that describes ENAV.

Attached hereto is a List of References Cited by Applicant listing the three references discussed above.

It is submitted that the three references discussed above establish that the accepted meaning of "ENAV" in the art on the filing date of October 16, 2003, of the present application was "enhanced navigation," not "enhanced audio [and] video" as erroneously indicated in paragraphs [0022] and [0070] of the specification and claim 23 of the present application as originally filed.

Furthermore, it is submitted that it would have been readily apparent to one of ordinary skill in the art from the entire disclosure of the present application as originally filed on October 16, 2003, that ENAV as used in the present application refers to the Enhanced Navigation technology developed by the DVD Forum that is described in the three references discussed above. See, for example, the following lines that appear in the STARTUP.HTM and B.HTM files listed on pages 24 and 25 of the specification:

```
<!DOCTYPE html PUBLIC "-//DVD/DTD XHTML DVD-HTML1.0//EN"  
"http://www.dvdforum.org/enav/dvdhtml-1-0.dtd">
```

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 12/19/07

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Attachments